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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,301

12/08/2003

Martin Sawicki

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05/02/2006

EXAMINER

BOTTS, MICHAEL K

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P.O. BOX 2903

MINNEAPOLIS, MN 55402-0903

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,301	SAWICKI ET AL.	
	Examiner	Art Unit	
	Michael K. Botts	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>June 7, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on December 8, 2003.
2. Claims 1-26 have been examined, with claims 1, 10, and 19 being the independent claims.
3. Claims 1-26 are rejected.

Information Disclosure Statement

4. A signed and dated copy of applicant's IDS, which was filed on June 7, 2004, is attached to this Office Action.

It is noted that the reference attributed to Chaudhuri was not considered and was stricken through in the IDS because it was not dated and the Examiner could not readily determine a date from the document.

It is noted that the reference attributed to Neumuller was not considered and was stricken through in the IDS because it was not dated and the Examiner could not readily determine a date or origin from the document. It is noted that what may be a partial date is observable.

Applicants are invited to resubmit the un-considered documents in a later IDS, along with appropriate date and origin designations, for consideration by the Examiner.

The Specification

5. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
7. The specification contains in excess of 300 lines of computer code and is required to be shortened or, in the alternative, deleted and re-submitted on a compact disk in compliance with 37 CFR 1.52(e). See, 37 CFR 1.96.

Claims Objections

8. **Claims 1, 4, 5, 10, 13, 14, 19, 23, and 24** are objected to because of the following informalities:
 - a) **Claims 1, 4, 5, 10, 13, 14, 19, 23, and 24**, use of the term "ML" as an abbreviation for the term "markup language." "ML" is not generally regarded as a standard abbreviation for that term. Applicant's are requested to consider amending the claims to use the phrase "markup language" for purposes of clarity.
 - b) **Claim 19**, at line 5, appears to repeat the phrase "is arranged to" as a typo. The phrase "is arranged to is arranged to" will be read as "is arranged to."

Appropriate correction is required.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-9, 19-26** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-9 and 19-26 are directed to nonfunctional descriptive material. See, MPEP 2106.IV.B.1.

Regarding **claims 1-9**:

Independent claim 1 recites computer-executable components on a computer-readable medium that are “arranged to . . .” Claims 2-9 inherit the rejection of claim 1 through their dependency on claim 1, and claims 2-9 do not remedy the grounds for the rejection. There is no functional relationship imparted by this data to a computing device. The claim describes software per se recorded on memory. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture. See, MPEP 2106.IV.B.1.

Regarding **claims 19 and 20-26**:

Independent claim 19 recites “a system for displaying and modifying electronic documents, comprising: an electronic document file . . . an editor that is arranged to is

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arranged to . . . and an encoder that is arranged to . . .” Claims 20-26 inherit the rejection of claim 19 through their dependency on claim 19, and claims 20-26 do not remedy the grounds for the rejection. There is no functional relationship imparted by this data to a computing device. The claim describes software per se recorded on memory. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture. See, MPEP 2106.IV.B.1.

10. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-26** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Altova Inc. & Altova GmbH, “XML Spy 4.0 Manual,” copyright 1998-2001, published September 9, 2001, pages 1-401, [hereinafter “XML Spy”].

Note that the elaboration of the grounds of the rejection begins with independent claim 10. Claims 1-9 recite similar subject matter to that specified in claims 10-18, but claims 1-9 are not used as the exemplary claims due to the lack of clarity of the claim language as is described above in the rejection of claims 1-9 under 35 U.S.C. 101. Claims 10-18 are used as the exemplary claims because they are not rejected under 35 U.S.C. 101 and are more clearly expressed.

Regarding claims 1-9:

Claims 1-9 incorporate substantially similar subject matter as claimed in claims 10-18, respectively, and are rejected along the same rationale.

Regarding independent claim 10, XML Spy teaches:

A method for handling electronic documents, comprising:
editing an electronic document comprising automatically generated
document properties;
prompting and receiving custom properties for the electronic document
from a user; and
encoding in an ML format the electronic document, the automatically
generated document properties, and the custom properties received from the
user.

(See, XML Spy, pages 1-401, teaching editing electronic documents with automatically generated properties, prompting and receiving custom properties for the electronic

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document from a user, and encoding the electronic document in a markup language, including the automatically generated document properties and the custom properties received from the user. See more specifically, XML Spy, pages 1-17 teaching editing and saving electronic documents in XML, a markup language, and see XML Spy, page 354 teaching prompting a user to edit an electronic document.)

Regarding **dependent claim 11**, XML Spy teaches:

The method of Claim 10, wherein the electronic document is a word-processor document.

(See, XML Spy, pages 198-207, teaching that the electronic document may be a word-processor document.)

Regarding **dependent claim 12**, XML Spy teaches:

The method of Claim 10, wherein the electronic document is a spreadsheet document.

(See, XML Spy, pages 67 and 99, teaching that the electronic document may be a spreadsheet.)

Regarding **dependent claim 13**, XML Spy teaches:

The method of Claim 10, further comprising generating backwards compatibility properties in response to a version number of the computer-

executable component, and wherein the third component is further arranged to encode the backwards compatibility properties in an ML format.

(See, XML Spy, pages 51-90 teaching versioning and backwards compatibility in a markup language format. See also, XML Spy, page 55, teaching document version identification.)

Regarding **dependent claim 14**, XML Spy teaches:

The method of Claim 13, further comprising generating application environment properties in response to an application environment of the computer-executable components, and wherein the third component is further arranged to encode the application environment properties in an ML format.

(See, XML Spy, pages 51-90 teaching versioning and backwards compatibility in a markup language format.)

Regarding **dependent claim 15**, XML Spy teaches:

The method of Claim 10, wherein the automatically generated document properties comprise a LastAuthor element.

(It is noted that the disclosure of the element "Last Author" states only that it is a property setting that "can be saved inside the 'DocumentProperties' element container," and that the term "represents the last author of the document." See, disclosure, page 8, lines 8-10.

See, XML Spy, page 132, teaching identification of the user, or author, in the save functions.)

Regarding **dependent claim 16**, XML Spy teaches:

The method of Claim 10, wherein the custom properties comprise a Married element of type Boolean.

(It is noted that the term “Married” occurs in the disclosure solely as an example of what might be saved in a “custom property setting.” See, disclosure, page 9, lines 26-28, and figure 5. Accordingly, the designation “Married” is read as non-functional descriptive material and not limiting of the claimed invention. Saving of a Boolean type property in a custom property function is read as limiting.

See, XML Spy, pages 287-362, teaching forms editing and custom properties, including Boolean value properties.)

Regarding **dependent claim 17**, XML Spy teaches:

The method of Claim 13, wherein the backwards compatibility properties comprise a Justification element.

(See, XML Spy, pages 147, 198, and 204, teaching forward and backward generation of XML document in structured formats.)

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Regarding **dependent claim 18**, XML Spy teaches:

The method of Claim 14, wherein the application environment properties comprise a zoom element.

(See, XML Spy, pages 136 and 191, teaching the zoom element.)

Regarding **independent claim 19**:

Claim 19 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.

Regarding **dependent claim 20**, XML Spy teaches:

The system of claim 19, wherein the electronic document is stored in a proprietary format.

(See, XML Spy, pages 380-388, teaching that XML Spy is a commercially licensed product and therefore, by definition, proprietary.)

Regarding **dependent claims 21-26** :

Claims 21-26 incorporate substantially similar subject matter as claimed in claims 11-16, respectively, and are rejected along the same rationale.

12. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.
See, MPEP 2123.

Conclusion

13. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Alshuler, L., "Getting the Tags In: Vendors Grapple with XML-Authoring, Editing and Cleanup," The Seybold Report on Internet Publishing, Volume 5, Number 6, February 2001, pages 1-6.

HV, Ltd., "WorX Standard Edition (SE) 'XML Authoring Made Easy'," HyperVision, Ltd., published on the Internet as of June 3, 2001 as a PDF file linked to <http://web.archive.org/web/20010603152210/www.hvltld.com/default.asp?name=information/xml/worxseOverview.xml&display=information/xsl/default.xsl>, pages 1-9.

Individuals associated with the filing or prosecution of a patent application are reminded of their obligations pursuant to 37 CFR 1.56. See generally, MPEP 2001 and subsections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read 'Doug Hutton', with a stylized, looping flourish at the end.

**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**